



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/872,633	06/01/2001	Yoshitaka Nishimoto	892_018	1715
25191	7590	09/09/2005	EXAMINER	
BURR & BROWN PO BOX 7068 SYRACUSE, NY 13261-7068			WU, RUTAO	
			ART UNIT	PAPER NUMBER
			3639	
DATE MAILED: 09/09/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/872,633

Applicant(s)

NISHIMOTO, YOSHITAKA

Examiner

Rutao Wu

Art Unit

3639

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 June 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "5" and "1" have both been used to designate "a communication interface". Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.
2. The drawings are objected to because on page 19 line 3 of the specifications, step S12 is in FIG 4 and not FIG 14. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must

be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to because FIG 20 shows that that if S214 is not [exchange] then the next step is S215. However, page 40 lines 19-20 of the specifications states that if S214 is not [exchange] then the processing goes forward to step S217. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New

Art Unit: 3639

Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

4. The disclosure is objected to because of the following informalities: Page 40 lines 19-20 of the specifications states that if S214 is not [exchange] then the processing goes forward to step S217. However, FIG 20 shows that that if S214 is not [exchange] then the next step is S215.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 1-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

8. Claim 1 recites the limitation "the read-out quality information" in line 16. There is insufficient antecedent basis for this limitation in the claim.

Art Unit: 3639

9. The limitation "the quality information is a using condition set with the using period being divided" in claims 7 and 18 are written in such a way that it cannot be understood by the examiner. Therefore the limitation is ignored by the examiner when applying prior art.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 12-22 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. A claim limited to a machine or manufacture which has practical application in the technological arts is statutory. In most cases, a claim to a specific

Art Unit: 3639

machine or manufacture will have practical application in the technological arts. See MPEP 2106, 2100-14 (quoting *In re Alappat*, 33 F.3d at 1544, 31 USPQ2d at 1557). Additionally, for subject matter to be statutory, the claimed process must be limited to a practical application of the abstract idea or mathematical algorithm in the technological arts. See *In re Alappat* 33 F.3d at 1543, 31 USPQ2d at 1556-57 (quoting *Diamond V. Diehr*, 450 U.S. at 192, 209 USPQ at 10). For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. See *In re Musgrave*, 431 F.2d 882, 167 USPQ 280 (CCPA 1970).

In the present case, claims 12-22 only recite an abstract idea. The recited steps of merely reading, storing, manipulating and transmitting information to users to determine the best price to which an item should be sold does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of how to determine the optimum price for an item.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. An invention, which is eligible or patenting under 35 U.S.C. 101, is in the "useful arts" when it is a machine, manufacture, process or composition of matter, which produces a concrete, tangible, and useful result. The fundamental test for patent eligibility is thus to determine whether the claimed invention produces a "use, concrete and tangible result". See *AT&T v. Excel Communications Inc.*, 172 F.3d at 1358, 50 USPQ2d at 1452 and *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d at 1373, 47 USPQ2d at 1601

Art Unit: 3639

(Fed. Cir. 1998). The test for practical application as applied by the examiner involves the determination of the following factors”

(a) “Useful” – The Supreme Court in *Diamond v. Diehr* requires that the examiner look at the claimed invention as a whole and compare any asserted utility with the claimed invention to determine whether the asserted utility is accomplished. Applying utility case law the examiner will note that:

i. the utility need not be expressly recited in the claims, rather it may be inferred.

ii. if the utility is not asserted in the written description, then it must be well established.

(b) “Tangible” – Applying *In re Warmerdam*, 33 F.3d 1354, 31 USPQ2d 1754

(Fed. Cir. 1994), the examiner will determine whether there is simply a mathematical construct claimed, such as a disembodied data structure and method of making it. If so, the claim involves no more than a manipulation of an abstract idea and therefore, is nonstatutory under 35 U.S.C. 101. In *Warmerdam* the abstract idea of a data structure became capable of producing a useful result when it was fixed in a tangible medium, which enabled its functionality to be realized.

(c) “Concrete” – Another consideration is whether the invention produces a “concrete” result. Usually, this question arises when a result cannot be assured. An appropriate rejection under 35 U.S.C. 101 should be

accompanied by a lack of enablement rejection, because the invention cannot operate as intended without undue experimentation.

In the present case, the claimed invention produces information for display (i.e., repeatable) used in determining the optimum price of a for sale item (i.e., useful and tangible).

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 12-22 are deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1-7, 9, 12-18, 20 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat No. 6,415,264 to Walker et al.

Referring to claims 1 and 12:

A support system for setting a price of a transaction target article in response to a request given from a requester, comprising:

a storage unit storing an identifying information for identifying the transaction target article and quality information for indicating a quality of the

Art Unit: 3639

transaction target article; (col 5: lines 24-30, 37-42, 52-56; col 6: lines 23-30; col 7: lines 29-32)

a receiving unit receiving the identifying information of the transaction target article of which a price should be set by the requester, and a quality evaluating information for evaluating a quality of the transaction target article; (col 5: line 27, 32-36)

a reading unit reading the quality information coincident with the received identifying information and quality evaluating information; and (col 5: lines 32-36)

a transmitting unit transmitting the read-out quality information to the requester. (col 5: lines 1, 22)

Referring to claims 2 and 13:

A support system for setting a price of a transaction target article according to claim 1, further comprising:

a transaction achievement information storage unit storing a transaction achievement information containing information on a transaction price of a transaction actually conducted with respect to the transaction article; and (col 5: lines 54-55; col 7: 10-13)

a statistic value calculating unit calculating, when said reading unit reads from said transaction achievement information storage unit at least one item of transaction achievement information coincident with the inputted identifying information and the read-out quality information, a statistic value of the

Art Unit: 3639

transaction price contained in at least one item of transaction achievement information that has been read out, (col 5: 23-25)

wherein said transmitting unit transmits the calculated statistic value of the transaction price requester. (col 5: lines 1, 22)

Referring to claims 3 and 14:

A support system for setting a price of a transaction target article according to claim 2, further comprising:

a necessary time related information storage unit storing an information relating to a necessary time for the transaction actually conducted with respect to the transaction target article, (FIG 4)

wherein said statistic value calculating unit calculates a statistic value of the necessary time on the basis of a single item or plural items of transaction achievement information read out from said transaction achievement information storage unit, and (FIG 4)

said transmitting unit transmits, to the requester, the statistic value of the necessary time together with the statistic value of the transaction price. (col 5: lines 1, 22)

Referring to claims 4 and 15:

A support system for setting a price of a transaction target article according to claim 3, further comprising

an extraction unit for extracting, when said receiving unit receives a desired transaction price of the transaction target article of which the price should

Art Unit: 3639

be set together with the identifying information and the quality evaluating information, an item of transaction achievement information relating to the transaction conducted in a price range inclusive of the desired transaction price out of the read-out items transaction achievement information, (col 7: lines 4-7)

wherein said statistic value calculating unit calculates a statistic value of the necessary time on the basis of the transaction achievement information extracted by said extraction unit, and (FIG 4)

said transmitting unit transmits the statistic value of the necessary time based on the extracted item of transaction achievement information to the requester. (col 5: lines 1, 22)

Referring to claims 5 and 16:

A support system for setting a price of a transaction target article according to claim 3, wherein said statistic value calculating unit calculates a statistic value of the transaction price and a statistic value of the necessary time in each of the plurality of price ranges set for the transaction target article of which the price should be set, and (FIG 8)

said transmitting unit transmits, to the requester, the calculated results of the calculations of the transaction prices and the necessary time corresponding to each of the price ranges. (col 8: 46-47)

Referring to claims 6 and 17:

A support system for setting a price of a transaction target article according to claim 3, wherein said statistic value calculating unit calculates a

statistic value of the transaction price and a statistic value of the necessary time in each of a plurality of advertising periods set for the transaction target article of which the price should be set, and (FIG 4)

said transmitting unit transmits, to the requester, the calculated results of the calculations of the transaction prices and the necessary time corresponding to each of the advertising periods. (col 5: lines 1, 22)

Referring to claims 7 and 18:

A support system for setting a price of a transaction target article according to claim 2, wherein the quality evaluating information is a using period of the transaction target article of which the price should be set, and (FIG 6A)

the quality information is a using condition set with the using period being divided.

Referring to claims 9 and 20:

A support system for setting a price of a transaction target article according to claim 1, wherein the quality evaluating information is an answer to a question about an assessment item with respect to the transaction target article of which the price should be set, and (col 6: lines 23-27)

The quality information is an assessment rank corresponding to an assessment score incremented or decremented corresponding to the answer to the question. (col 6: lines 23-27)

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. As per claims 8 and 19, the examiner takes official notice that it is obvious to one skilled in the arts that if a component is too old or has exceeded its usable life span then no one would purchase the component. Therefore it would be unnecessary to calculate and statistic value for the component.

14. Claims 10 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al.

Walker discloses claimed matter as described above.

Walker does not disclose explicitly that an item post to be sold is a component of a vehicle.

Examiner submits however, that it would have been obvious to one having ordinary skill in the art at the time the invention was made to include components of a vehicle or any other good or service. Walker provides specific motivation by indicating that any types of good or service may be sold (col 3: lines 45-54).

15. Claims 11 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al in view of U.S. Pat No. 5,657,233 to Cherrington et al.

Walker does not disclose a maintenance information storage unit stored with maintenance information of a vehicle. Walker also does not disclose using the vehicle maintenance information to obtain the using period.

Cherrington discloses a specifications database which contains vehicle specifications and a customer/inspection database which contains prior inspection records.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Walker's invention to include a vehicle maintenance information database and the ability to use the information to calculate the using time of a vehicle's component. One would be motivated to perform such a modification to have an alternate solution to providing the quality condition of an item for sale.

Conclusion

16. Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Art Unit: 3639

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following patents are cited to further show the state of the art with respect to cost estimating systems in general:

U.S. Pat No. 5,546,564 to Horie.

U.S. Pat No. 6,415,270 to Rackson et al.

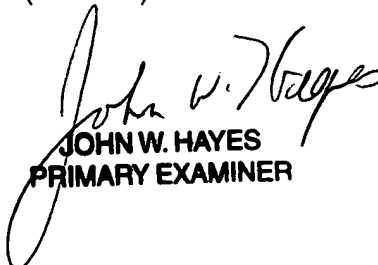
U.S. Pat No. 6,622,129 to Whitworth.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rutao Wu whose telephone number is (571)272-3136.

The examiner can normally be reached on Mon-Fri 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571)272-6708. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


JOHN W. HAYES
PRIMARY EXAMINER